

REMARKS

This is in response to the Office Action mailed August 23, 2006. In the Office Action, Claims 14-27 were rejected under 35 USC 103 as being unpatentable over U.S. Patent No. 5,488,478 to Bullock et al. in view of U.S. Patent No. 4,623,258 to Task et al. Claim 15 was also rejected under 35 USC 103 as being unpatentable over Bullock and Task as applied to Claim 14 and further in view of U.S. Patent No. 5,339,154 to Gassler et al.

At the outset, Applicants acknowledge with appreciation the Examiner's withdrawal of U.S. Patent No. 5,592,246 to Kuhn et al. as a basis for rejection. However, for reasons set forth in greater detail below, Applicants submit that like Kuhn, the newly cited Task reference is not analogous prior art, and any proposed combination of Bullock with Task would not have rendered the claims, as amended, obvious.

With respect to the claims, Applicants note that independent claims 14, 20, 21 and 23 have been amended to (1) more clearly express the method steps of the present invention and (2) more clearly distinguish the claimed method over the method and system described in Task. For example, the claims have been amended to recite "providing a moving metal strip having a surface to be measured" and "providing a light source and a transparency between the light source and the metal strip surface," (Claim 14) or "delivering light through the transparency and onto the strip surface" (Claims 20, 21 and 23). The method of the present invention further includes producing a pattern on the metal strip surface that is to be measured using the light source. The method

further includes viewing of the pattern formed on the metal strip surface with a camera and determining the geometry of the metal strip surface.

First and foremost, Applicants respectfully submit that the method of the present invention, as recited in the claims, is neither shown nor suggested in the Task reference. Task is only concerned with measuring haze in a transparency such as an aircraft window. The transparency is the object that is being measured. As such, Applicants respectfully submit that Task is not analogous prior art as required because it is not in the field of Applicants' endeavor and not reasonably pertinent to the particular problem with the claimed invention is concerned.

It is well settled that "[I]n order to rely on a reference as a basis for rejection of an Applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F2d 1443, 1447 (Fed. Cir. 1992). "If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problems If the prior art is directed to a different purpose and different structures, other than the purpose addressed by the claimed invention, the inventor would have had less motivation or occasion to consider it." In re Clay, 966 F2d 656, 659 (Fed. Cir. 1992).

Based on the Federal Circuit's definition of what is and what is not analogous prior art, Task falls well outside the realm of relevant prior art because it is (1) neither within the Applicants' field of endeavor (2) nor is it pertinent to the particular problem being addressed by the invention. As noted above, Task is concerned with measuring haze in a transparency such as an aircraft window, where the transparency is the object

under analysis. Task does not utilize a transparency to determine the geometry of a solid object, and in fact, no such object is disclosed or suggested in Task. In contrast, in the present invention, the transparency is used as a tool to produce a pattern on the subject article, in this case the opaque surface of a moving metal strip.

Task does not disclose viewing the pattern on the metal strip with a camera or otherwise. In Task, there is no object or pattern beyond the transparency to be viewed. Task does not disclose determining the geometry of the metal strip based on the produced pattern because, once again, Task is not interested in measuring the geometry or surface evenness of anything. For these reasons, Task cannot be said to be from the same field of endeavor, namely, the measuring and determining of the geometry and surface evenness of a moving flat and opaque object.

Turning to the second prong of the Federal Circuit's test for analogous prior art, Task is not reasonably pertinent to the particular problem with which the inventor is involved. As noted above, the present invention is directed to measuring the flatness of a moving metal strip. Task as described above, is interested in measuring the haze of a stationary transparent object. These are different problems. There is absolutely no recognition or appreciation in Task of measuring anything other than haze in the stationary transparency. As such, the system and method described in Task is in no way pertinent to Applicants' problem in determining the flatness of a moving metal (and opaque) strip. Thus, Task fails the second prong of the Federal Circuit's analogous prior art test and for this reason cannot be the basis for rejection of the present claims.

Other differences between Task and the present invention are that Task measures luminance by means of a photometer. The claims of the present invention

recite use of a camera for viewing the pattern formed on the moving metal strip. Indeed, the shape of the pattern on the surface is important information that is needed to successfully measure the geometry and surface evenness of the strip. Information about the luminance of a metal strip as measured with a photometer provides no useful information for determining the geometry and surface evenness of the metal strip.

In view of these fundamental differences between the subject matter of Bullock and the above-described subject matter of Task, Applicants submit that one of skill in the art with knowledge of Bullock would have had absolutely no reason to consider the system in Task. Bullock provides no motivation for using a transparency to form a pattern on a moving metal strip and even he did, Task provides no teaching of using the transparency to project a pattern onto the surface of the metal strip. Alternatively, one with knowledge of Task and its system of measuring a stationary transparent object would have no reason to look to the moving metal strip system of Bullock. In short, regardless of how one attempts to combine the prior art relied upon by the Examiner, one would still not be led to the present invention.

Applicants respectfully submit that the claims, as amended, are now in condition for allowance. Reconsideration and allowance of such claims are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Andrew G. Kolomayets", written over a horizontal line.

Andrew G. Kolomayets
Registration No. 33,723

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
200 West Adams Street - #2850
Chicago, IL 60606
(312) 236-8500